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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,163	01/16/2001	Florian Pestoni	ARC920000106US1	9807

26381 7590 01/20/2006
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EXAMINER

MORGAN, ROBERT W

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,163	Applicant(s) PESTONI ET AL.	
	Examiner Robert W. Morgan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 11/1/05, the following has occurred: Claims 1-8 have been amended and claims 9-32 have been withdrawn. Claims 1-8 are presented for examination.

Claim Objections

2. The claim objection has been withdrawn by the Examiner based on the changes made by the Applicant to the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over “eMedia-IT and Lloyds of London Provide Global Insurance for Digital Content” by PR Newswire (hereinafter “Newswire”) in view of U. S. Patent No. 6,708,157 to Stefik et al., for substantially the same reasons given in the previous Office Action (see paper dated 8/1/05). Further reasons appear below

(A) Claims 1-8 have been amended to now recite the step of “...purchased distributed digital content”, “...said purchased digital content”, “...specified purchased digital content”, and “...said content insurance was also purchased”.

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As per the limitations "...purchased distributed digital content" and "...said purchased digital content", it has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As per the limitation "...specified purchased digital content" and "...said content insurance was also purchased". The Newswire reference is relied on for teaching the obtaining global insurance for digital content called Insure-IT (see: abstract). Additionally, Newswire teaches coverage includes, but is not limited to, loss of service, defamation of subscriber's reputation or character, infringement of any right to privacy, plagiarism, piracy, infringement of copyright, and damage to files (see: paragraph 6). The Examiner considers the Insure-IT insurance as coverage against damaged files such as insuring digital content against a loss. The Stefik reference is relied on teaching a digital ticket that may be used to in many commercial scenarios such as the purchase of software, which is the digital content (see: column 4, lines 24-26). In addition, Stefik teaches a consumer buys a digital work together with an agreement to upgrade to a new version at a later date for a modest fee, much less than the usual purchase price (see: column 47, lines 16-21).

The motivation to combine the teachings of Stefik within the Newswire reference are discussed in the rejection of claim 1 in the previous Office Action dated 8/1/05, and incorporated herein.

Response to Arguments

Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 3/7/05.

(A) In the remarks, Applicants argue in substance that, (1) the Examiner's rejections fails to establish a *prima facie* case of obviousness using three basic criteria (a) there must be some suggestion or motivation to combine or modify the references, (b) there must be a reasonable expectation of success, and (c) the prior art must teach or suggest each and every limitation of the claimed invention; (2) the teachings to combine references must come from the references themselves; (3) there is no nexus to combine eMedia-IT with Stefik and no suggestion, motivation, or teachings within the references themselves that would lead to make the combination; (4) Newswire focuses on securely storing a user's data teaches away from Stefik as Stefik is interested in distribution on an author's digital works, not the user's; (5) the combination of references does not provide, nor suggest a method of insuring purchased distributed digital content; (6) eMedia-IT and Stefik do not provide a new copy of lost data or insure purchase digital content and therefore is silent with respect to format; (7) Stefik does not describe, nor suggest any encoding format changes as is claimed by the present invention; (8) Stefik does not describe payment for encoding format upgrades and is silent as to any "limited time" periods as recited in claim 6; (9) Stefik does not sell the customer insurance and therefore cannot satisfy the claim language elements as recited in claim 7; (10) eMedia-IT and Stefik are silent on the features of claim 8 "...includes any of: restrictions on the number of claims that can be filed, payment of a deductible for a claim, requiring disclosure of private information by said

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consumer when making a claim, or having a limited term with the option of renewal”.

(B) In response to Applicants arguments that, (1) the Examiner's rejections fails to establish a *prima facie* case of obviousness using three basic criteria (a) there must be some suggestion or motivation to combine or modify the references, (b) there must be a reasonable expectation of success, and (c) the prior art must teach or suggest each and every limitation of the claimed invention and (2) the teachings to combine references must come from the references themselves The Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper dated 8/1/05).

As such, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art,

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rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Further, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a

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holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the prior Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, the primary motivation for combining the respective teachings of Newswire and Stefik et al. was clearly recited as "...providing a reliable and secure way of protecting and compensating a user in case of catastrophic media failure" (see: paper dated 8/1/05, starting last paragraph of page 4 to page 5). Not only was this motivation explicitly recited in the rejection of the claims, it was based solely on the teachings of the prior art, namely, column 38, lines 8-10 of Stefik et al. As such, the Examiner respectfully contends that the first requirement needed to establish a *prima facie* case of obviousness, namely, a showing of a suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, has been clearly established in the rejection applied in this case.

(C) In response to Applicants arguments that, (3) there is no nexus to combine eMedia-IT with Stefik and no suggestion, motivation, or teachings within the references themselves that would lead to make the combination; and (4) Newswire focuses on securely storing a user's data teaches away from Stefik as Stefik is interested in distribution on an author's digital works, not the user's. The Examiner respectfully submits that this is not evidence that the applied references teach away from applicant invention. In addition, it is the Newswire reference relied on for the teachings of global insurance for digital content called Insure-IT with coverage that includes, but is not limited to, loss of service, defamation of subscriber's reputation or character, infringement of any right to privacy, plagiarism, piracy, infringement of copyright, and damage to files (see: abstract and paragraph 6). Stefik is relied on for teaching consumer's buying digital works

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together with an agreement to upgrade to a new version at a later date for a modest fee, much less than the usual purchase price (see: column 47, lines 16-21). Furthermore, it is respectfully submitted that if Applicant's were correct in his assertion which Examiner does not admit, it has been held that prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In addition, the motivation to combined the teachings of the Stefik et al. within Newswire reference as given in section 6 of the previous Office Action is suggested from a passage in the Stefik et al. column 38, lines 6-12, "...providing a reliable and secure way of protecting and compensating a user in case of catastrophic media failure".

(D) In response to Applicants arguments that, (5) the combination of references does not provide, nor suggest a method of insuring purchased distributed digital content. The Examiner respectfully submits the Newswire reference teaches the obtaining global insurance for digital content called Insure-IT (see: abstract). The Stefik reference teaches a digital ticket that may be used to in many commercial scenarios such as the purchase of software, which is the digital content (see: column 4, lines 24-26). In addition, Stefik teaches a consumer buys a digital work together with an agreement to upgrade to a new version at a later date for a modest fee, much less than the usual purchase price (see: column 47, lines 16-21). This clearly indicates that a consumer purchases the digital content using the digital ticket as described by Stefik and may insure this digital content using the Insure-IT coverage described by Newswire.

(E) In response to Applicants arguments that, (6) eMedia-IT and Stefik do not provide a new copy of lost data or insure purchase digital content and therefore are silent with respect to

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format. The Examiner respectfully submits that the Newswire reference, and not Stefik, *per se*, that was relied upon for the specific teaching of obtaining global insurance for digital content called Insure-IT (see: abstract). Additionally, Newswire teaches coverage includes, but is not limited to, loss of service, defamation of subscriber's reputation or character, infringement of any right to privacy, plagiarism, piracy, infringement of copyright, and damage to files (see: paragraph 6). Stefik was relied on for primarily teaching a digital ticket that may be used to in many commercial scenarios such as the purchase of software, which is the digital content (see: column 4, lines 24-26). In addition, Stefik et al. teaches a restore transaction where a request is made to convert a backup copy of a digital work into a usable copy (see: column 38, lines 6-12). Thus, the proper combination of the applied references would be the incorporation of Stefik et al. purchasing of digital content including a restore transaction within the insurance for digital content called Insure-IT of Newswire.

(F) In response to Applicants arguments that, (7) Stefik does not describe, nor suggest any encoding format changes as is claimed by the present invention. The Examiner respectfully submits that Stefik reference teaches that a consumer buys the digital work with an agreement that he could upgrade to new version at a later date (see: column 46, lines 51-56). Furthermore, Stefik teaches that usage rights are treated as part of a digital work and usage rights statements are encoded in suitable form for accessing during the processing of a transaction such as whether a digital work can be copied, when and how it can be used and what fees are to be charged (see: column 17, lines 40-53 and column 11, lines 16-17). Therefore, the Examiner considers any purchased upgraded version of a digital content to include encoded format changes.

(G) In response to Applicants arguments that, (8) Stefik does not describe payment for encoding format upgrades and is silent as to any “limited time” periods as recited in claim 6. The Examiner respectfully submits that the claim language uses the terms “...include any of” and is written in the alternative, therefore satisfying this limitation would only require finding either “a limited number of format upgrades or a limited time for which upgrades are available with the option of renewal”. The Stefik reference teaches limiting the number of format upgrades to one per copy of the digital work (see: column 47, lines 23-25).

(H) In response to Applicants arguments that, (9) Stefik does not sell the customer insurance and therefore cannot satisfy the claim language elements as recited in claim 7. The Examiner respectfully submits that the Newswire reference, and not Stefik, *per se*, that was relied upon for the specific teaching of obtaining global insurance for digital content called Insure-IT (see: abstract). Additionally, Newswire teaches coverage includes, but is not limited to, loss of service, defamation of subscriber’s reputation or character, infringement of any right to privacy, plagiarism, piracy, infringement of copyright, and damage to files (see: paragraph 6). Basic coverage through the MediaDepot insurance policy is \$250 (U.S.) per year and also can be customized for subscriber’s special needs (see: paragraph 6). Stefik was relied on for primarily teaching a digital ticket that may be used to in many commercial scenarios such as the purchase of software, which is the digital content (see: column 4, lines 24-26). In addition, Stefik et al. teaches a restore transaction where a request is made to convert a backup copy of a digital work into a usable copy (see: column 38, lines 6-12). Thus, the proper combination of the applied references would be the incorporation of Stefik et al. purchasing of digital content including a restore transaction within the purchase of basic or customized insurance coverage of Newswire.

(I) In response to Applicants arguments that, (10) eMedia-IT and Stefik are silent on the features of claim 8 "...includes any of: restrictions on the number of claims that can be filed, payment of a deductible for a claim, requiring disclosure of private information by said consumer when making a claim, or having a limited term with the option of renewal". The Examiner respectfully submits that the claim language uses the terms "...include any of" and is written in the alternative, therefore satisfying this limitation would only require finding either "restrictions on the number of claims that can be filed, payment of a deductible for a claim, requiring disclosure of private information by said consumer when making a claim, or having a limited term with the option of renewal". The Stefik reference teaches the restrictions on the number of claims that can be filed to one per copy of the digital work (see: column 47, lines 23-25).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

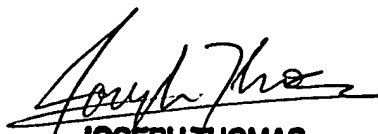
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773.

The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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